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In re Application of	:	
Zheludev et al.	:	
Application No.: 09/937,736	:	DECISION ON
PCT No.: PCT/GB00/01199	:	
Int. Filing Date: 29 March 2000	:	PETITION
Priority Date: 29 March 1999	:	
Attorney's Docket No.: H48.12-0001	:	UNDER 37 CFR 1.47(b)
For: TRANSMITTING AND RECEIVING	:	
APPARATUS	:	

This is a decision in response to the "Petition To Make Application For Patent On Behalf Of And As Agent For Joint Inventors Who Refuse To Sign (37 CFR 1.47(b))" filed on 06 May 2002 to accept the application without the signature of inventors Nikolay Zheludev and Boris Kokorin.

BACKGROUND

On 29 March 2000, applicant filed international application PCT/GB00/01199 that claimed priority of an earlier British application filed 29 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 October 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 27 October 2000 prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 29 September 2001.

On 28 September 2001, applicant filed a letter for entry into the national stage in the United States which was accompanied by a copy of the International Application, a preliminary amendment, drawing sheets, an abstract, a copy of the International Search

Report and the basic national fee of \$430 as required by 35 U.S.C. 371(c). These papers were assigned application number 09/937,736.

On 06 November 2001, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration and a surcharge fee. The notification set a two-month time period in which to respond.

On 06 May 2002, applicant filed a "Petition Under 37 CFR 1.47(b) to Accept Application Without Inventor's Signature."

In order to satisfy the requirements of 35 U.S.C. 371(c)(4), on 06 May 2002, applicants filed the following papers:

- 1) a Response to Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) including a Petition under 37 CFR 1.47(a);
- 2) the required petition fee;
- 3) the \$65 surcharge for providing the oath/declaration after 30 months from the earliest priority date;
- 4) a declaration executed by Richard Wardle (Director of Hex Technology Holdings Limited) on behalf of Nikolay Zheludev and Boris Kokorin; and,
- 5) various documents intended to show that inventors Nikolay Zheludev and Boris Kokorin have refused to sign the application papers and to establish the proprietary interest of Hex Technology Holdings Limited .

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.37(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. Applicant has satisfied items (1), (3), (4), (5) and (6).

With respect to item (1), applicant has provided the \$130 petition fee. With respect to item (3), applicant has provided a statement of the last known address of both Nikolay Zheludev and Boris Kokorin. With respect to item (4), applicant has provided a declaration executed by Richard Wardle (Director of Hex Technology Holdings Limited) on behalf of Nikolay Zheludev and Boris Kokorin. With respect to item (5), applicant has provided a copy of assignment documents from both Nikolay Zheludev and Boris Kokorin for the earlier British application which is identical to the current application. With respect to item (6), Mr. Wardle has provided the required statement.

MPEP §409.03(b) states, in part:

“Where inability to find or reach a nonsigning inventor “after diligent effort” is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.”

With respect to item (2) above, there is no indication in Mr. Wardle's statement that a delivery of the application papers was ever attempted to either Nikolay Zheludev and Boris Kokorin. Although, Mr. Wardle states that he forwarded a copy of the Declaration and Power of Attorney to Mr. Kokorin's attorney, he does not mention the application papers. Further, Mr. Wardle admits that he did not even attempt to deliver the Declaration and Power of Attorney to Mr. Zhedudev since he stated that he would not sign. Further, other than Mr. Wardle's conversation with Mr. Kokorin's attorney, there is absolutely no indication that any attempt has been made to locate Mr. Kokorin in South Africa. Mr. Wardle's statement that “The lawyer confirmed, on 30th April 2002, that this had been forwarded to Mr. Kokorin but that he had not by then signed and that I should not expect him to do so” is a statement based on heresy which is unacceptable.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED**.

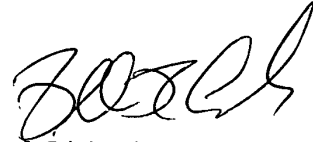
If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Should status under 37 CFR 1.47(b) not be successfully completed, the international application will be viewed as becoming abandoned with respect to the United State at midnight at the expiration of the time period set in this decision or as extended by any extension see timely paid under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C., 20231, with the contents of this letter marked to the attention of the PCT Legal Office.



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